

### **REMARKS**

The Final Office Action of October 25, 2004, has been carefully considered by the Applicants. Claims 1, 2, 4-26, 28, and 29 are pending. Claims 4-8, 11-13, 15-17, 20-26, and 29 have been amended. Claims 1, 2, and 19 have been cancelled.

**A. No new matter has been introduced in the disclosure.**

In paragraph 4, the Examiner objected to the amendment filed on August 11, 2004, under 35 U.S.C. § 132 as introducing new matter into the disclosure. The Examiner alleged a lack of antecedent basis for disclosures of a “charge transport polymer” (emphasis in original) in the amended paragraph beginning at page 6, line 4 of the specification.

Applicants have amended the paragraph to cancel the matter relating to the word “polymer.” With regards to the amendment “X, wherein when X is alkyl, X contains from about 1 to about 12 carbons atoms and the aryl amine is dispersed in a highly insulating and transparent resinous binder,” (underlined words added in this amendment), support may be found in original claims 14-16. In *Triax Co. v. Hartman Metal Fabricators Inc.*, 479 F.2d 951, 178 USPQ 142, 146 (2d. Cir. 1973), the court said that if later-submitted material “simply clarifies or completes the prior disclosure it cannot be treated as new matter.” In *Quigley v. Zimmerman*, 73 F.2d 499, 503, 23 USPQ 310 (CCPA 1934), the court stated:

That amendments may be made to patent applications for the purpose of curing defects, obvious to one skilled in the art, in the drawings or written descriptions of inventions, is so well settled that we deem it unnecessary to cite authorities in support thereof.

Applicants submit that this amendment therefore cannot be treated as new matter. As is clear from the amendment, this phrase should not be interpreted to mean that “the aryl amine of the formula disclosed in the paragraph comprises the group X, which is defined as an alkyl having about 1 to about 12 carbon atoms,” as the Examiner suggested in paragraph 2 of the Office Action dated February 10, 2004.

Applicants request withdrawal of the objection under 35 U.S.C. § 132.

**B. Informalities have been corrected.**

In paragraph 5, item 1, the Examiner objected to the charge transport polymer polysebacoyl-TBD (PSEB) described in the paragraph beginning at page 6, line 4 of the specification. The paragraph has been amended to remove this polymer and claim 19 has been cancelled.

In paragraph 5, item 2, the Examiner objected to the example beginning at page 18, line 26 of the specification. Applicants believe the Examiner is saying the example does not enable claim 11. However, the reaction scheme of claim 11 is described in the paragraph beginning at page 3, line 21 of the specification. In this regard, Applicants believe claim 11 is therefore enabled and allowable.

In paragraph 5, item 3, the Examiner objected to the disclosure "aryl amine contains from about 1 to about 12 carbon atoms" in the paragraph beginning at page 6, line 4 of the specification. This disclosure has been clarified as described above.

In paragraph 6, the Examiner objected to the disclosure of cross-linking of "about 6% to about 9%" (emphasis in original) in the paragraph beginning at page 8, line 14 of the specification. The Examiner alleged the basis of the cross linking was unclear. This disclosure has been removed from the specification.

Withdrawal of the objections for informalities is requested.

**C. The claims comply with 35 U.S.C. § 112.**

In paragraph 8, claims 22 and 23 were rejected under 35 U.S.C. § 112, ¶ 2, as indefinite. Applicants traverse the rejections. The Examiner alleged lack of unambiguous antecedent basis in the recitation "charge blocking layer" (emphasis added). Applicants have amended claims 22 and 23 to recite the phrase "hole blocking layer."

In paragraph 10, claim 19 was rejected under 35 U.S.C. § 112, ¶ 1 for failing to describe polysebacoyl-TBD. Claim 19 has been cancelled and the paragraph beginning at page 6, line 4 of the specification has been amended to remove reference to polysebacoyl-TBD.

In paragraph 11, claims 11, 28, and 29 were rejected under 35 U.S.C. § 112, ¶ 1 for failing to describe "combinations thereof." Claims 11 and 29 have been amended to remove this phrase.

Withdrawal of the rejection under 35 U.S.C. § 112, ¶ 2 is requested.

**D. The claims are not obvious.**

In paragraphs 15-28, the Examiner rejected several claims under 35 U.S.C. § 103(a) as obvious. In these paragraphs, the Examiner referred to Grant & Hackh, Borsenberger, and Knauf '767 to provide specific teachings. Since these references are not pertinent to the arguments made below, they will not be listed in the following paragraphs.

In paragraph 15, claims 1, 2, 7-9, 22-24, and 26 were rejected under 35 U.S.C. § 103(a) as obvious over Hendrickson '673 and Ong '877. Applicants traverse the rejections.

Hendrickson and Ong '877 together do not teach all claim limitations. Hendrickson in particular does not teach a cross-linked silicone rubber *and* a resilient electrically insulating overcoat layer. He teaches only one layer, a topcoat, comprised of a silicone polymer. However, he does not teach *two* separate and distinct layers as the claims require and as described in the two paragraphs beginning at page 16, line 10 of the specification. Ong '877 does not correct this deficiency; he does not teach any coating over the charge transport layer at all. Therefore, Hendrickson and Ong '877 do not render the instant claims obvious. Withdrawal of the rejections is requested.

In paragraph 16, claims 4 and 5 were rejected under 35 U.S.C. § 103(a) as obvious over Hendrickson '673, Ong '877, and Horgan '995. Applicants traverse the rejections. As mentioned, the references do not render obvious the claims upon which claims 4-5 depend. Additionally, claims 4 and 5 have been amended to depend upon claim 10, which was previously allowed. Therefore, they are not obvious. Withdrawal of the rejections is requested.

In paragraph 18, claims 1, 2, 6-9, 11-16, 20-24, 26, and 28 were rejected under 35 U.S.C. § 103(a) as obvious over Ong '737 and Hendrickson '673. Applicants traverse the rejections.

As previously stated, Hendrickson only teaches one layer over the charge transport layer, not two. Ong '737 does not correct this deficiency; he does not teach any coating over the charge transport layer at all. Therefore, Hendrickson and Ong '737 do not render the instant claims obvious. Withdrawal of the rejections is requested.

In paragraph 19, claims 4 and 5 were rejected under 35 U.S.C. § 103(a) as obvious over Ong '737, Hendrickson '673, and Horgan '995. Applicants traverse the rejections. As mentioned, the references do not render obvious the claims upon which claims 4-5 depend. Additionally, claims 4 and 5 have been amended to depend upon claim 10, which was previously allowed. Therefore, they are not obvious. Withdrawal of the rejections is requested.

In paragraph 21, claims 1, 2, 6-9, 12-16, 20-24, and 26 were rejected under 35 U.S.C. § 103(a) as obvious over Ong '877, Brown '220, and Hendrickson '673. Applicants traverse the rejections.

As previously stated, Ong '877 and Hendrickson together do not teach all claim limitations because they do not teach two separate layers of a silicone rubber and a resilient, electrically insulating overcoating layer. Brown teaches two separate layers, a barrier layer and a release layer. However, he teaches away from the instant claims. At col. 4, lines 39-44, Brown states that the barrier layer lays between the photoconductive layer and the release layer. He then explicitly states that the barrier layer should not be a silicone layer; see col. 4, lines 64-67. The instant claims require Brown's barrier layer to be a cross-linked silicone rubber. Thus, Brown does not correct the deficiency of Ong '877 and Hendrickson and the instant claims are not obvious. Withdrawal of the rejections is requested.

In paragraph 22, claims 4 and 5 were rejected under 35 U.S.C. § 103(a) as obvious over Ong '877, Brown, Hendrickson, and Horgan. Applicants traverse the rejections. As mentioned, the references do not render obvious the claims upon which claims 4-5 depend. Additionally, claims 4 and 5 have been amended to depend upon claim 10, which was previously allowed. Therefore, they are not obvious. Withdrawal of the rejections is requested.

In paragraph 24, claims 1, 2, 6-9, 12-18, 21-24, and 26 were rejected under 35 U.S.C. § 103(a) as obvious over Pai '880, Brown, and Hendrickson. Applicants traverse the rejections.

As previously stated, Hendrickson only teaches one layer over the charge transport layer, not two. As previously stated, Brown teaches away from the instant claims. Pai does not correct these deficiencies; he also teaches only one overcoat layer and does not teach any specific composition for the layer. Therefore, the instant claims are not obvious over Pai, Brown, and Hendrickson. Withdrawal of the rejections is requested.

In paragraph 25, claims 4 and 5 were rejected under 35 U.S.C. § 103(a) as obvious over Pai, Brown, Hendrickson, and Horgan. Applicants traverse the rejections. As mentioned, the references do not render obvious the claims upon which claims 4-5 depend. Additionally, claims 4 and 5 have been amended to depend upon claim 10, which was previously allowed. Therefore, they are not obvious. Withdrawal of the rejections is requested.

In paragraph 26, claim 19 was rejected under 35 U.S.C. § 103(a) as obvious over Pai, Brown, Hendrickson, and Yanus. Although Applicants do not believe claim 19 is made obvious by the cited references, claim 19 has been cancelled in order to expedite prosecution.

In paragraph 28, claims 1, 2, 6-9, 12-18, 21-23, 25, and 26 were rejected under 35 U.S.C. § 103(a) as obvious over Pai and Kando '267. Applicants traverse the rejections.

Claims 1 and 2 have been cancelled. Claims 4-8, 11-13, 17, and 20-26 have been amended to depend upon claim 10, which was previously allowed. Withdrawal of the rejections is requested.

### CONCLUSION


For the above reasons, all remaining claims (4-28, 20-26, 28, and 29) are believed to be in a condition for allowance. The foregoing comments do not require unnecessary additional search or examination.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby authorized to call Richard M. Klein, at Telephone Number (216) 861-5582.

Respectfully submitted,

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